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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/733,102  
Filing Date: December 10, 2003  
Appellant(s): ELKADY ET AL.

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Karl T. Rees  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10/28/2010 appealing from the Office action mailed 5/11/2010.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

Claims 1-29 and 31

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

**(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

**(8) Evidence Relied Upon**

7,099,027	Barry et al.	8-2006
7,202,972	Schwier et al.	4-2007

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barry et al. (US 7,099,027) hereinafter 'Barry' in view of Schwier et al. (US 7,202,972) hereinafter 'Schwier'.

Regarding Claim 1: (Currently Amended)

Barry discloses a method comprising:

receiving, at a merge utility (Figure 8: Summing Junction 804) executing on a computer system (e.g., Workstation), a request to merge (In order to merge the system must receive a merge command/request from the browser or program code) a first merge document (802 PDL in) with a second document (New PDL Info 806)

wherein the second merge document is in the merge format (PDL);

wherein the step of converting is performed by either the merge utility or the first document authoring application (The Summing Junction 804 merges new PDL information from Block 806 with the original PDL input job; Column 13, lines 15-18);

the merge utility merging the first merge document and the second merge document to generate a composite merge document (The output of the summing clock 804 which is in PDL format; Column 13, lines 18-19); and

after generating the composite merge document delivering said composite merge document to an output device (e.g., PDL document is sent to printer);

wherein the output device is a device that is different from the computer system (e.g., Figure 18; Output Device is Printer 1810, and Computer System is Workstation 1802);

wherein the merge format is a format that is supported by the output device (e.g., PDL); and

therefore does not need to be converted to another format that is supported by the output device in order to be properly interpreted by the output device (The Printer inherently understands PDL).

wherein the method is performed by one or more computing devices (e.g., the plurality of workstations 1802 in the job distribution printing system of Figure 18; Column 21, lines 21-24).

Barry does not disclose expressly a document in an original format;  
wherein the second document was created in said original format by a first document authoring application;  
in response to the request, causing the second document to be converted from the original format to the merge format to create a second merge document;  
wherein the original format is a format that is not supported by the output device and therefore needs to be converted to another format that is supported by the output device in order to be properly interpreted by the output device.

Schwieb discloses a document in an original format (Figure 6; Winword document 35);  
wherein the second document was created in said original format by a first document authoring application (Winword);  
in response to the request (In order to merge the system must receive a merge command/request from the browser or program code), causing the second document to be converted from the original format to the merge format to create a second merge document (Document converted to PCL format; Column 8, lines 13-14); wherein the original format is a format that is not supported by the output device and therefore needs to be converted to another format that is supported by the output device in order to be properly interpreted by the output device;(Figure 8 shows an Application 45 created in Microsoft Word which is converted by Printer Processor 49 to PCL which is a printer language that the printer understands).

Schwier & Barry are combinable because they are from the same field of endeavor of image processing; e.g. both references disclose methods of merging print jobs and converting them into a format that can be understood by printers. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to convert a document from e.g. Word for Windows format to PCL or Postscript prior to merging that document with another PCL or Postscript formatted document. The suggestion/motivation for doing so is to avoid substantial time delays because the static data must be continuously transmitted from the generating computer system to the printer device, i.e. with every individual document as disclosed by Schwier in the Background of Invention. Schwier further discloses that when two documents are merged and when the data from one document contains the same information, that RAM memory, disk storage, transmission capacity etc. are adversely affected and result in reduced printing performance. As a result, data to be displayed or printed must be first rasterized by a raster image processor (RIP), which utilizes complex and time-consuming computational routines which further increase production time to an economically impractical level. Therefore, it would have been obvious to combine Schwier's conversion of a Windows based document into a print language such as PCL or postscript with Barry's Distributed Print Job Method to obtain the invention as specified to quickly produce customized and/or personalized information within a single production run.

Regarding Claim 2: (original)

Schwier further discloses the method of claim 1 further comprising:

generating the first merge document in said merge format by converting a first original document from an original format to the merge format (Document converted to PCL format; Column 8, lines 13-14).

Regarding Claim 3: (original)

Schwier further discloses the method of claim 1, wherein the merge format is Standard Printing and Imaging Format (SPIF) (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or postscript').

Regarding Claim 4: (original)

Schwier further discloses the method of claim 3, wherein the merge format is PDL Postscript (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or postscript').

Regarding Claim 5: (original)

Schwier further discloses the method of claim 1, wherein the first document is a background template document and the second document is an overlay document (Column 8, lines 64-67; 'The placement type as an **overlay** (complete superimposition) or a **watermark** (macro information only in the background) within the document **can be selected** with the selection field 44').

Regarding Claim 6: (previously presented)

Schwieber further discloses the method of claim 5, wherein the background template document is originally created by a second document authoring **application** (Column 5, lines 23-30; 'Various application programs in turn run under this operating system, for example the **application** 10 Winword 97.RTM. from the Microsoft Office 97.RTM. package'); and

wherein the second document authoring application is different (Column 5, lines 35-38; 'The variable data areas are intended to be filled with variable data that are stored in a separate datafile (a Word document, data bank, an Excel document, etc.) from said first document authoring application.

#### Regarding Claim 7: (original)

Schwieber further discloses the method of claim 5, wherein the background template document is created in a second original format (Column 5, lines 35-38; 'The variable data areas are intended to be filled with variable data that are stored in a separate datafile (a Word document, data bank, an Excel document, etc.) and converted from the second original format to the merge format (Document converted to PCL format; Column 8, lines 13-14).

#### Regarding Claim 8: (Currently Amended)

Barry and Schwieber further discloses the method of claim 1, wherein causing the second document to be converted from the original format to the merge format comprises the merge utility converting the second document to the merge format.

Note: The Examiner respectfully believes that the combination of references discloses this feature and that this limitation is addressed in the rejection of claim one, note the Applicant's limitation at lines 7-9.

Regarding Claim 9: (Currently Amended)

Schwier further discloses the method of claim 1, wherein the converting of the second document from the original format to the merge format to create the second merge document includes:

generating, based on the original format, a set of conversion instructions (e.g., The instructions that are input at a user interface which for example may describe how a template or overlay is to appear; Column 4, lines 24-27; The conversion that is controlled by the parameters that were previously input via the Input module 59; Column 9, lines 65-67);

passing the set of conversion instructions to a document authoring application  
(The 'logical linking' of reference data and parameters described at Column 4, lines 15-30); and

the first document authoring application generating the second merge document based on said set of conversion instructions (Column 4, lines 15-20).

Regarding Claim 10: (previously presented)

Schwier further discloses the method of claim 1, wherein the method further comprises receiving a request to merge documents containing information about a document authoring application (Column 4, lines 25-26; 'the referencing is thereby particularly controlled via data that are input via a user interface') that created the second document; and

wherein the converting of the second document from the original format to the merge format to create the second merge document includes:

generating, based on the information about the document authoring application, a set of conversion instructions (The program code or device which enables the PCL converter 18 in Figure 2) to convert the second document into said second merge document;

passing the set of conversion instructions to the document authoring application (Column 9, lines 59-62; "Enhanced Print Environment (EPE) Print Processor" 49a does not forward the EMF data directly to the port monitor 51 but calls the converter unit 58, wherein the EMF data stream is converted into a PCL print data stream 60'); and

the document authoring application generating the second merge document based on said set of conversion instructions (Column 9, lines 65-67, 'The conversion is thereby controlled by the parameters that were previously input via the input module 59').

Regarding Claim 11: (original)

Schwieb further discloses the method of claim 1, wherein the composite merge document is in the merge format (Column 3, lines 56-67).

Regarding Claim 12: (original)

Schwieb further discloses the method of claim 1, wherein the composite merge document is a **template** for creating other documents (FIG. 5 shows a **master** document 25).

Regarding Claim 13: (previously presented)

Schwieb further discloses the method of claim 1, further comprising;

Receiving at the merge utility, a request to merge wherein the steps of converting the second document and merging the first merge document and the second merge document are both performed in response to the merge utility receiving the request to merge documents. documents (The program code which is embodied on a computer readable media and operable to requests the merge utility described in Column 6, lines 8-18 to merge documents and in Claim 20.)

Regarding Claim 14: (previously presented)

Schwieb further discloses the method of claim 1 further comprising:

receiving at the merge utility, a request to merge documents (Column 7, lines 20-25; in order to merge the system must receive a merge command);

generating the first merge document in said merge format by converting a first original document from an original format to the merge format (See PCL converter 18 in Figure 2);

wherein the merge format is Standard Printing and Imaging Format (SPIF) (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or postscript'); wherein the first document is a background template document and the second document is an overlay document (Column 8, lines 64-67; 'The placement type as an **overlay** (complete superimposition) or a **watermark** (macro information only in the background) within the document **can be selected** with the selection field 44').

wherein the background template document is originally created by a first document authoring application (e.g., WinWord Application 10 in Figure 2); and

wherein the second document authoring application that is different from said first document authoring application (e.g., Excel document);

wherein the background template document is created in a second original format and converted from the second original format to the merge format (e.g., Master Document described in Column 9, lines 32-35).

Regarding Claim 29: (previously presented)

Schwier discloses the method of Claim 1, wherein the first merge document is a version of a first document that has been converted from an original format to the merge format (e.g., Word application converted to PCL as shown in Figure 9).

Regarding Claim 30: (previously presented)

Schwier further discloses the method of Claim 1, wherein the merge utility performs the step of converting a second document from an original format to the merge format to create a second merge document by causing the first document authoring application to convert the second document to to said second merge document (Figure 8 shows an Application 45 created in Microsoft Word which is converted by Printer Processor 49 to PCL which is a printer language that the printer understands).

Regarding Claims 15-28, and 31:

The proposed combination of Barry and Schwier, explained in the rejection of method claims 1-14 and 29, renders obvious the steps of the machine readable storage medium of Claims 15-28 and 31 because these steps occur in the operation of the proposed combination as discussed above. Thus, the arguments similar to that presented above for claims 1-14 and 29 are equally applicable to Claims 15-28 and 31.

**(10) Response to Argument**

Regarding Applicant's Argument (page 7, lines 1 and 2):

*"Neither reference teaches that a merge utility responds to a request to merge a document in an original format with a document in a merge format."*

Examiner's Response:

Barry discloses receiving, at a merge utility (Figure 8: Summing Junction 804) executing on a computer system (e.g., Workstation), a request to merge (In order to merge the system must receive a merge command/request from the browser or program code) a first merge document (802 PDL in) with a second document (New PDL Info 806).

This summing junction 804 is a conversion operation which requires introduction of instruction or extraction of instructions therefrom as disclosed by Barry (Column 13, lines 15-18). Barry further discloses instruction sets defining the instructions that are to be carried out that are to be processed from an instruction register 922. These are contained in job block 906, which represents all of the instruction sets, distribution controls etc.

Note: Applicant states that the 'alleged' merge utility does not receive a "request" within the meaning of Claim 1, but further goes on to say that "the alleged merge utility responds to a request to merge..." (page 7, lines 10-13). Applicant appears to be tacitly acknowledging this limitation in the Barry reference.

Regarding Applicant's Argument (page 8, lines 21-22):

*"Neither reference features a merge utility that causes a document to be converted from an original format to a merge format."*

Examiner's Response:

Schwier discloses a document in an original format (Figure 6; Winword document 35); wherein the second document was created in said original format by a first document authoring application (Winword); in response to the request (In order to merge the system must receive a merge command/request from the browser or program code), causing the second document to be converted from the original format to the merge format to create a second merge document (Document converted to PCL format; Column 8, lines 13-14)

The Examiner respectfully believes that combining Schwier & Barry would have been obvious to a person of ordinary skill in the art at the time of the invention. Essentially both references contain merge utilities, one which merges two PCL feeds into one (Barry) and another which takes a document in an original format and converts that document into a format that is 'merge-ready i.e. PCL' (Schwier).

Hence the prior art includes each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of an actual combination of the elements in a single prior art reference. Therefore one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately. The results of the combination would have been predictable and resulted in modifying the invention of Barry to include the conversion of e.g., a Word document into PCL as taught by Schwier.

Regarding Applicant's Argument (page 10, lines 7-9):

*"Passing instructions to Schwier's PCL Convertor 18 does not teach or suggest passing instructions to a document authoring application that produced the document in the original format."* and

*"Passing conversion instructions to Schwier's PCL Convertor 18 after merger does not teach or suggest passing conversion instructions to a document authoring application before merger."*

Examiner's Response:

The Examiner respectfully disagrees with Applicant's assertion that the Schwier reference does not disclose the passing of instructions to the document authoring application that produced the document in the original format before the merger. The instructions that are input at a user interface which for example may describe how a template or overlay is to appear; Column 4, lines 24-27; The conversion that is controlled by the parameters that were previously input via the Input module 59; Column 9, lines 65-67 and passing the set of conversion instructions to a document authoring application (The 'logical linking' of reference data and parameters described at Column 4, lines 15-30).

Regarding Applicant's Argument (page ; page 12, lines 1-4):

*"Schwier does not describe a merge request that "contains information about the first document authoring application."*

*"The mere fact that PCL convertor 18 is enabled by program code or a device does not show that a set of conversion instructions is generated "based on the information about the document authoring application" included in the merge request*

Examiner's Response:

Schwier discloses wherein the method further comprises receiving a request to merge documents containing information about a document authoring application (Column 4, lines 25-26; 'the referencing is thereby particularly controlled via data that are input via a user interface') that created the second document; and

wherein the converting of the second document from the original format to the merge format to create the second merge document includes:

generating, based on the information about the document authoring application, a set of conversion instructions (The program code or device which enables the PCL converter 18 in Figure 2) to convert the second document into said second merge document;

passing the set of conversion instructions to the document authoring application (Column 9, lines 59-62; "Enhanced Print Environment (EPE) Print Processor" 49a does not forward the EMF data directly to the port monitor 51 but calls the converter unit 58, wherein the EMF data stream is converted into a PCL print data stream 60'); and

the document authoring application generating the second merge document based on said set of conversion instructions (Column 9, lines 65-67, 'The conversion is thereby controlled by the parameters that were previously input via the input module 59').

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Neil R. McLean/

Examiner, Art Unit 2625

Conferees:

/David K Moore/

Supervisory Patent Examiner, Art Unit 2625

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